Attorney Docket No:004341.P053D2 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of : Scott Adams et al. Application No.: 10/766,720 Filed: January 27, 2004 For: ELECTROSTATIC ACTUATOR FOR MICROELECTROMECHANICAL SYSTEMS AND METHODS OF FABRICATION Issued as U.S. Patent No. 7,098,571 on August 29, 2006	Examiner: Tamai, Karl I. Art Unit: 2834 Confirmation No.: 3457

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND PURSUANT TO 37 CFR §1.26(a)

Sir:

Applicants respectfully request a refund of a petition fee for the above-identified patent application and entry of the previously submitted Cross-Reference to Related Applications. Applicant filed a Cross-Reference to related applications under 37 CFR §1.78 on July 3, 2006. However, the Cross-Reference was improperly treated as a petition for a delayed claim for priority rather than the intended Cross-Reference to related applications.

The above-referenced patent claims priority from and is a divisional of U.S. Patent Application No. 09/775,491, filed February 2, 2001, entitled Electrostatic Actuator for Microelectromechanical Systems and Methods of Fabrication, which issued as U.S. Patent No. 6,753,638 on June 22, 2004. Priority was claimed in the filing of the divisional application and in a preliminary amendment dated January 27, 2004.

Prior to issuance of the above-referenced patent, applicant filed a Cross-Reference to related applications under 37 CFR §1.78 on July 3, 2006 to notify the Office of the following related patents and patent applications:

(1) U.S. patent application no. 09/775,491, filed February 2, 2001, entitled Electrostatic Actuator for Microelectromechanical Systems and Methods of Fabrication, which issued as U.S. Patent No. 6,753,638 on June 22, 2004, and which claims the benefit of provisional patent application no. 60/179,912, filed February 3, 2000;

(2) U.S. patent application no. 10/766,087, filed January 27, 2004, entitled Electrostatic Actuator for Microelectromechanical Systems and Methods of Fabrication, which issued as U.S. Patent No. 7,261,826 on August 8, 2008;

(3) U.S. patent application no. 09/231,082, filed January 14, 1999, entitled Trench Isolation For Micromechanical Devices, which issued as U.S. Patent No. 6,239,473 on May 29, 2001, and which claims the benefit of provisional patent application no. 60/071,390, filed January 15, 1998;

(4) U.S. patent application no 09/548,680, filed April 13, 2000, entitled Trench Isolation for Micromechanical Devices, which issued as U.S.

Patent No. 6,342,430 on January 29, 2002, and which is a divisional of U.S. patent application no. 09/231,082, filed January 14, 1999, and which claims the benefit of provisional patent application no. 60/071,390, filed January 15, 1998;

(5) U.S. patent application no. 09/231,083, filed January 14, 1999, entitled Integrated Large Area Microstructures and Micromechanical Devices, which claimed the benefit of provisional patent application no. 60/071,569, filed January 15, 1998;

(6) U.S. patent application no. 10/083,600, filed February 27, 2002, entitled Integrated Large Area Microstructures and Micromechanical Devices, which issued as U.S. Patent No. 6,756,247 on June 29, 2004, which is a divisional of U.S. patent application no. 09/231,083, filed January 14, 1999, which claims the benefit of provisional patent application no. 60/071,569, filed January 15, 1998.

Applicant only identified related applications prior to the issuance of the above-reference patent. **This was not a petition to change the existing priority claim or to include additional claims for priority**. Pursuant to §1.78(d)(6), a Cross-Reference to a related application may be made without a claim for priority. Accordingly, applicant respectfully submits that the original Cross-Reference was proper and requests that the Cross-Reference be entered.

Furthermore, as the Cross-Reference was improperly treated as a petition for a delayed claim for priority, the Office of Petitions charged Deposit Account No. 02-2666 a petition fee totaling $1370.00 pursuant to §1.17(t). No fee was required for a Cross-Reference under §1.78(a)(2) (now §1.78(d)(6)). Accordingly, applicants request a refund in the amount of $1370.00. Enclosed please find a copy of the

Decision on Petition mailed September 6, 2007, showing the amount of the fee charged to our deposit account. Applicant respectfully requests that the refund in the amount of $1370.00 be credited to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: January 15, 2009

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In re Patent No. 7,098,571 :
Issue Date: August 29, 2006 :
Application No. 10/766,720 : DECISION ON PETITION
Filed: January 27, 2004 : UNDER 37 CFR 1.78(a)(3) and (a)(6)
Attorney Docket No. 4341P053D2 :

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed July 10, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The instant petition does not comply with items (1) and (3). Pursuant to petitioner's request deposit account no. 02-2666 will be charged the $1370.00 petition fee.

As to item (1), the amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i) and 37 CFR 1.78(a)(5)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that

specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office. Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in 37 CFR 1.121.

The "amendment" fails to comply with 37 CFR 1.78 because the amendment fails to state the relationship between each application and includes unnecessary information interspersed between the claims for priority. Petitioner may wish to review MPEP 201.11 for a more detailed discussion of the proper format for amendments adding priority claims.

As to item (3), petitioner has failed to provide a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

The patent issued August 29, 2006. Therefore, any request for reconsideration must include $100 and a request for a certificate of correction. Petitioner should note the contents of MPEP 1481.03 prior to filing a request for consideration. MPEP 1481.03 states in part,

> Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application filed on or after November 29, 2000...
>
> Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct:
> (A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2); or
> (B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).
>
> Where priority is based upon 35 U.S.C. 120 to a national application, the following conditions must be satisfied:
> (A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;
> (B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and
> (C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Charlema Grant at (571) 272-3215.

C. Steven Brantley
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Office of Petitions